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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/661,348
Filing Date: September 12, 2003
Appellant(s): TEMPEST ET AL.

Stephen C. McKenna
For Appellant

EXAMINER'S ANSWER

This examiner's answer is responsive to the remand from the Board of Appeals dated June 3, 2010 and replaces the examiner's answer of February 10, 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is deficient. 37 CFR 41.37(c)(1)(v) requires the summary of claimed subject matter to include: (1) a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number, and to the drawing, if any, by reference characters and (2) for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the

structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. The brief is deficient because it contains numerous features which are not recited in the claims. For example, the description of claim 1 recites that the bonus indicator does not award credits when a certain result is obtained, but rather indicates whether or not the player of the primary game is entitled to proceed to a bonus feature. Nowhere in claim 1 is this feature, particularly the failure to award credits, recited. The summary of claim 22 recites that the bonus indicator is not a play for credit game. Again, this is not recited in claim 22. Similar language is included in the summary of claims 49 and 51, but not recited in the claims themselves.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

NEW GROUND(S) OF REJECTION

Claims 49 and 50 are rejected under 35 USC § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,652,378

CANNON

11-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-9, 22-30, 31-41 and 49-51 are rejected under 35 USC 102(e) as being anticipated by Cannon. The rejections are set forth more fully in the Final Rejection dated October 5, 2007.

NEW GROUND(S) OF REJECTION

Claims 49 and 50 are rejected under 35 USC § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim(s) recites/recite the following means (or step) plus function limitation:

[M]eans for initiating a bonus feature for said primary game
where said bonus indicator designates a bonus condition.

This limitation invokes 35 USC § 112, ¶ 6 because it meets the 3-prong analysis set forth in MPEP 2181 as it recites the phrase “means for” or “step for” (or appellant identifies the limitation as a means (or step) plus function limitation in the appeal brief) and the phrase is modified by functional language and it is not modified by sufficient structure, material, or acts for performing the recited function. Also see *Altiris Inc. v.*

Semantec Corp., 318 F.3d 1363, 1375 (Fed. Cir. 2003). 35 USC § 112, ¶ 6, requires such claim to be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. "If one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section § 112." In re Donaldson Co., 16 F.3d 1189, 1195, 29 USPQ 1845, 1850 (Fed. Cir. 1994)(in banc.). For a computer-implemented means-plus-function claim limitation that invokes 35 USC § 112, ¶ 6, the corresponding structure is required to be more than simply a general purpose computer. Aristocrat Technologies, Inc. v. International Game Technology, 521 F.3d 1328, 1333, 86 USPQ2d 1235, 1239-40 (Fed. Cir. 2008). The corresponding structure for a computer-implemented function must include the algorithm as well as the general purpose computer. WMS Gaming, Inc. v. International Game Technology, 184 F.3d 1339, 51 USPQ2d 1385 (Fed. Cir. 1999). The written description must at least disclose the algorithm that transforms the general purpose microprocessor to a special purpose computer programmed to perform the claimed function. Aristocrat, 521 F.3d at 1338, 86 USPQ2d at 1242.

In the instant application, the following portions of the specification and drawings may appear to describe the corresponding structure for performing the claimed function:

The gaming machine of the present invention can be produced using electronic components that are conventional and in widespread use in the gaming industry. There are many combinations of components which will satisfactorily

produce the desired features. One skilled in the art of logic and circuit design can readily make many and varying embodiments of the invention described herein. The gaming machine may be connected to an overall casino management system which monitors and controls its operation. Page 6, line 20 to page 7, line 4.

However, the specification and drawings do not disclose sufficient corresponding structure for performing the claimed function. For the Specification to only disclose a general purpose computer as the structure designed to perform the means for initiating the bonus feature amounts to pure functional claiming. To say that this is within the capability of a person of ordinary skill in the art and therefore unnecessary to designate any particular algorithm to perform the claim function is contrary to the CAFC's precedent of, in return for a generic claiming ability, the applicant must indicate in the specification what structure constitutes the means. For if it is not clear as to the structure that is intended to correspond to the claimed function, then the applicant has not paid the price, but is attempting to claim in functional terms that which is unbounded by any reference to structure in the specification.

(10) Response to Argument

Cannon is directed to a gaming machine where a plurality of games may be played simultaneously. See column 8, lines 33-45. Column 8, line 66 to column 9, line 29 of Cannon describes various types of games which may be played simultaneously, including spinning reel slot machines, poker games, blackjack games, keno, roulette, bingo etc. With respect to applicant's arguments that Cannon requires a separate credit for each game, while the claimed invention recites a bonus indicator which is enabled

by credit wagered in a primary game, Cannon discloses in column 26, lines 21-63 that a player may be presented with a "complementary game" which is displayed simultaneously with a primary game (the Office Action of October 5, 2007 erroneously refers to column 23 for this disclosure). Lines 34-37 recite that a "complimentary game may be caused to play automatically in response to a player's initiation of play in one or more other games of chance in which wagers have been placed". Here, the "one or more other games" is a primary game, and the complimentary game is a bonus indicator. Lines 46-49 explicitly recite that a wager amount on a primary game may also be applied to the complementary game. The complementary game operates independently of the primary game. This language reads on the claimed limitation that the bonus indicator is enabled by credit wagered in a primary game. It should also be noted that at least with respect to apparatus claims 49 and 51, the phrase "enabled by credit wagered in said primary game" is functional language which describes the intended purpose of the apparatus, rather than reciting further structural limitations to the claims.

The appellant is correct that the secondary games described in column 8, lines 33-45 and column 8, line 66 to column 9, line 29 and the complementary game described in column 26, lines 21-63 are considered by the examiner to be a "bonus indicator" and that any winnings from such games are considered by the examiner to be a "bonus feature". The games indicate whether the player is entitled to a bonus. The appellant is essentially arguing that Cannon fails to disclose certain limitations which may be described in the specification, but are not recited in the claims. Although the

claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). While appellant argues that the terms "bonus indicator" and "bonus feature" have specific definitions in the specification, the specification fails to provide such definitions. Rather, certain alternative embodiments have merely been deleted from the specification, in the Amendment dated October 3, 2006. Particularly in light of the recitation in certain dependent claims, including claims 3-6, 24-27 and 35-38 that the bonus indicator is a "roulette type wheel" or "one or more reels" Cannon reads on the claimed features under the broadest reasonable interpretation of the claim language. The "bonus feature" in particular cannot have any special definition because the specification as originally filed did not even mention a "bonus feature", much less provide a special definition. The amendment to the specification merely recites that a player may "participate in a bonus round or feature". On its face this does not constitute a special definition of "bonus indicator" or "bonus feature", and it cannot be interpreted as such because to do so would result in the introduction of new matter into the disclosure.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Kurt Fernstrom/
Primary Examiner, Art Unit 3711

June 25, 2009

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/DONALD T HAJEC/

Director, Technology Center 3700

Conferees:

/Gene Kim/

Supervisory Patent Examiner, Art Unit 3711

/XUAN M. THAI/

Supervisory Patent Examiner, Art Unit 3715